

## **ADMINISTRATIVE PANEL DECISION**

British American Tobacco (Brands) Limited v. Privacy service provided by Withheld for Privacy ehf / Isreal S Conteh, B Australia  
Case No. D2022-3140

### **1. The Parties**

The Complainant is British American Tobacco (Brands) Limited, United Kingdom, represented by Demys Limited, United Kingdom.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Isreal S Conteh, B Australia, Gambia (the).

### **2. The Domain Name and Registrar**

The disputed domain name <bat-au.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 25, 2022. On August 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 25, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 26, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 26, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 26, 2022.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on October 4, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant is a member of the British American Tobacco Group of Companies, a British multinational cigarette and tobacco manufacturing company headquartered in London. It was founded in 1902 and now operates in around 180 countries and employs over 95,000 staff. In 2021, it reported revenues of GBP 25.684 billion.

The Complainant owns a large global portfolio of registrations for the mark BAT, the earliest of which is United Kingdom Trademark Registration No. 2135480, registered on February 27, 1998.

The disputed domain name was registered on February 15, 2022, and displays a parking page displaying Pay-Per-Click (“PPC”) links, provided by the registrar of record.

In addition, the Complainant was made aware of the disputed domain name when it was alerted to it by an individual who had been approached via email by an entity purporting to be the Complainant. The emails made employment offers to the recipient. The disputed domain name can be found in some footers of those emails.

The Complainant observes that the exhibited documents also reference <career-bat.com> and <careers-bat.com> in some footers. These were the subjects of *British American Tobacco (Brands) Limited v. Proxy Protection LLC / Isreal S Conteh*, WIPO Case No. [D2022-1792](#); and *British American Tobacco (Brands) Limited v. Contact Privacy Inc. Customer 0163501448 / James Onuoha Doe, Bat Corps*, WIPO Case No. [D2022-1353](#), respectively, which indicates that the controlling entity behind these domain names and the disputed domain name are likely to be one and the same.

#### 5. Parties’ Contentions

##### A. Complainant

Firstly, the Complainant contends that the disputed domain name is confusingly similar to registered trademarks in which the Complainant has rights. The Complainant further avers that the additional adornment “au” (presumably in this context an abbreviation of “Australia”) is descriptive and generic and does nothing to distinguish the disputed domain name from the Complainant’s marks. The top-level domain “.com” is required only for technical reasons.

Secondly, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. In particular, the Complainant has found no evidence that the Respondent has been commonly known as BAT or BAT AU prior to or after the registration of the disputed domain name. Furthermore, the Respondent is not a licensee of the Complainant and has not received any permission or consent from the Complainant to use its trademarks, company name or to offer employment opportunities on the Complainant’s behalf. The Complainant asserts that the disputed domain name has not been used in connection with any legitimate noncommercial or fair use, without intent for commercial gain, as the Complainant observes that the disputed domain name has been used in connection with a parking page displaying PPC links and an advance fee fraud scam. In any event, the Complainant can conceive of no circumstances in which the appropriation of its name and mark within the disputed domain name for the purposes of fraud (or, indeed, any other purpose) could be considered a *bona fide* use.

Thirdly, the Respondent's registration and use of the disputed domain name constitutes – in the Complainant's view – bad faith. It is obvious to the Complainant that the Respondent registered the disputed domain name to ensure that potential victims of the fraud scam would think any email correspondence sent to and from the disputed domain name originated from the Complainant. Equally, given the incorporation of the Complainant's name and mark as the most dominant element of the disputed domain name, the Complainant can envisage no circumstances in which the disputed domain name could be registered and used in good faith in terms of the Policy.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

### **A. Identical or Confusingly Similar**

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first of all establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The Complainant has provided evidence that it is the registered owner of registrations for the trademark BAT, e.g. United Kingdom Trademark Registration No. 2135480, registered on February 27, 1998.

While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)). This Panel shares this view and notes that the Complainant's registered trademark BAT is fully included in the disputed domain name.

According to the consensus view of UDRP panels, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see [WIPO Overview 3.0](#), section 1.8). It is the view of this Panel that the trademark BAT is clearly recognizable within the disputed domain name. Consequently, the combination of that trademark with the letters “au”, being the two letter country code for Australia, does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark.

Hence, this Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark pursuant to the Policy, paragraph 4(a)(i). Policy paragraph 4(a)(i) is satisfied.

## **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to a disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complainant's uncontested evidence, the disputed domain name resolves to a commercial parking website displaying PPC links. In addition, the Complainant has undisputedly contended and evidenced that the disputed domain name has also been used in connection with email correspondence by someone purporting, falsely, to be the Complainant and making employment offers to the recipient. UDRP panels have categorically held that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent (see [WIPO Overview 3.0](#), section 2.13.1, with further references).

In any case, the Panel holds that such use cannot be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, since such use capitalizes on the reputation and goodwill of the Complainant's trademarks and is likely to mislead Internet users (see, e.g., *TELUS Corporation v. Fortefusion Fortefusion, Wordcounts*, WIPO Case No. [D2021-0787](#)).

In addition, the Respondent did not submit any evidence of *bona fide* pre-Complaint preparations to use the disputed domain name. As outlined above, the Complainant's uncontested allegations demonstrate that it has not authorized the Respondent's use of the BAT-trademark for registering the disputed domain name, which is confusingly similar.

Furthermore, the Panel notes that there is no evidence in the record showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, the Panel also notes that there is no evidence in the record either showing that the Respondent might be making a noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy. In particular, the disputed domain name is being used for a commercial parking website displaying PPC links, so that a noncommercial use thereof is excluded from the outset. In addition, the use of the disputed domain name for fraudulent emails excludes any fair use of the disputed domain name from the outset.

It is acknowledged that once the Panel finds a *prima facie* case has been established, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain

circumstances specified in paragraph 4(b) of the Policy may, “in particular but without limitation”, be evidence of the disputed domain name’s registration and use in bad faith.

It is the view of this Panel that the Respondent has indeed registered the disputed domain name and is using it in bad faith.

As explained above, it results from the Complainant’s documented allegations that the disputed domain name is used in connection with email correspondence by someone purporting, falsely, to be the Complainant and making employment offers to the recipient. The Panel notes the approach taken by previous UDRP panels finding that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. Many such cases involve a respondent’s use of a domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by a complainant’s actual or prospective customers (see [WIPO Overview 3.0](#), section 3.4).

As explained above under section 6.B., the use of the disputed domain name for an illegal email scam in the name of the Complainant demonstrates that the Respondent not only knew of the Complainant and its marks, but also attempted to pass itself off as the Complainant. For the Panel, it is therefore evident that the Respondent positively knew the Complainant and its trademarks. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant’s trademark BAT identically when it registered the disputed domain name. Registration of a domain name, which contains a third party’s trademark, in awareness of said trademark and in the absence of rights or legitimate interests is suggestive of registration in bad faith (see, e.g., *TELUS Corporation v. Fortefusion Fortefusion, Wordcounts*, WIPO Case No. [D2021-0787](#); *Charlotte Tilbury TM Limited v. Domains By Proxy, LLC / Qiangdong Liu, 365rw.com.ltd*, WIPO Case No. [D2020-0408](#)).

The finding of bad faith registration and use is supported by the following further circumstances resulting from the case file:

- (i) the Respondent’s failure to submit a response;
- (ii) the Respondent’s failure to provide any evidence of actual or contemplated good-faith use; and
- (iii) the implausibility of any good faith use to which the disputed domain name may be put.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <bat-au.com> be transferred to the Complainant.

*/Tobias Malte Müller/*

**Tobias Malte Müller**

Sole Panelist

Date: October 18, 2022